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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/511,582 02/23/00 RAA

J CU-2140 TJK

EXAMINER

HM22/0220

Timothy J Keefer
Ladas & Parry
224 South Michigan Avenue
Chicago IL 60604

STUCKER, J

ART UNIT

PAPER NUMBER

1648

DATE MAILED:

02/20/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

Applicant(s)

Examiner

Group Art Unit

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

- ☒ Responsive to communication(s) filed on 1/25/01
- ☒ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- ☒ Claim(s) 1-88/3 is/are pending in the application.
- Of the above claim(s) _____ is/are withdrawn from consideration.
- ☐ Claim(s) _____ is/are allowed.
- ☒ Claim(s) 1-88/3 is/are rejected.
- ☐ Claim(s) _____ is/are objected to.
- ☐ Claim(s) _____ are subject to restriction or election requirement.

Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
 - ☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been received.
 - ☐ received in Application No. (Series Code/Serial Number) _____
 - ☐ received in this national stage application from the International Bureau (PCT Rule 1.7.2(a)).

*Certified copies not received: _____

Attachment(s)

- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____
- ☐ Interview Summary, PTO-413
- ☐ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Other _____

Office Action Summary

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This Office Action is in response to the amendment filed 1/25/01. Claims 9-12 are canceled. Claims 1-8 and 13 are pending and under final rejection.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

The rejection of claim 1 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention is **withdrawn** in view of applicant's amendment.

The rejection of claims 1-13 under 35 U.S.C. 112, first paragraph is **withdrawn** in view of applicant's amendment.

The rejection of claims 1, 2, 4-8, and 13 are rejected under 35 U.S.C. § 102(b) as being anticipated by Benach et al. **is maintained**.

Applicant's arguments have been fully considered but are not deemed to be persuasive. Applicant argues that amended claim one defines the instant invention over the art, specifically, that the reference teaches β -1,3 glucopyranose derivatives with no disclosure or evidence of the structure of the glucophranose. This is

not persuasive because the limitation is an inherent property of the chemical and would be expected for the prior art chemical as well. Claiming a new use, new function, or unknown property which is inherently present in the prior art does not necessarily make the claim patentable. Therefore, the instant invention is anticipated by Benach et al.

The rejection of claims 1, 2, 4-8, and 13 under 35 U.S.C. § 102(b) as being anticipated by Takahashi et al. **is maintained.**

Applicant's arguments have been fully considered but are not deemed to be persuasive. Applicant argues that amended claim one defines the instant invention over the art, specifically, that the reference does not teach any side chains and that the glucan of the claimed method contains the 1,3 main chain and are essentially devoid of any side chain as only a "residue" (?) is disclosed as being attached to the main chain. This is not persuasive. It is first noted that the claimed invention is directed to a composition, not a method. Applicant's statement that the instant compound is devoid of any side chain appears to contradict the claim which specifically requires 1,6 side chains. Takahashi et al. does teach 1,6 side chains, see the table and column 1, line 16, as well as elsewhere, thereby meeting the limitation of the

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claims. Thus, the instant invention is anticipated by Takahashi et al.

The rejection of claims 1 and 3 are rejected under 35 U.S.C. § 103(a) as obvious over Benach et al. **is withdrawn.**

The following is a new ground of rejection necessitated by amendment:

Claims 2-8 and 13 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

There is no antecedent basis for "substances".

No claims are allowed.

Applicant's amendment necessitated the new ground of rejection. Accordingly, **THIS ACTION IS MADE FINAL.** See M.P.E.P. § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 C.F.R. § 1.136(a).

A SHORTENED STATUTORY PERIOD FOR RESPONSE TO THIS FINAL ACTION IS SET TO EXPIRE THREE MONTHS FROM THE DATE OF THIS ACTION. IN THE EVENT A FIRST RESPONSE IS FILED WITHIN TWO MONTHS OF THE MAILING

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DATE OF THIS FINAL ACTION AND THE ADVISORY ACTION IS NOT MAILED UNTIL AFTER THE END OF THE THREE-MONTH SHORTENED STATUTORY PERIOD, THEN THE SHORTENED STATUTORY PERIOD WILL EXPIRE ON THE DATE THE ADVISORY ACTION IS MAILED, AND ANY EXTENSION FEE PURSUANT TO 37 C.F.R. § 1.136(a) WILL BE CALCULATED FROM THE MAILING DATE OF THE ADVISORY ACTION. IN NO EVENT WILL THE STATUTORY PERIOD FOR RESPONSE EXPIRE LATER THAN SIX MONTHS FROM THE DATE OF THIS FINAL ACTION.

Papers related this application may be submitted to Group 1600 by facsimile transmission. Papers should be faxed to Group 1600 via the PTO Fax Center located in Crystal Mall 1. The faxing of such papers must conform with the notice published in the Official Gazette, 1096 OG (November 15, 1989).

The Group 1600 Fax numbers are: (703) 308-4242 and (703) 305-3014.

Unofficial communications may be faxed to: (703) 308-4426.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey Stucker whose telephone number is (703) 308-4237. The examiner can normally be reached Monday to Thursday from 7:00am to 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Housel, can be reached on (703) 308-4027.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0196.


JEFFREY STUCKER
PRIMARY EXAMINER